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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/788,734

02/27/2004

Ramnath N. Iyer

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34769

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12/20/2007

NEW MARKET SERVICES CORPORATION
(FORMERLY ETHYL CORPORATION)
330 SOUTH 4TH STREET
RICHMOND, VA 23219

EXAMINER

GOLOBOY, JAMES C

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

12/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/788,734

Applicant(s)

IYER ET AL.

Examiner

James Goloboy

Art Unit

1797

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11/30/07 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attached sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Attachment to Advisory Action


1. Applicant has amended claim 30 and its dependent claims to include a limitation involving the maximum torque difference of the power transmission fluid between 400 and 1000 seconds as determined on a ZF GK rig using the GVRK-Kurztest CFT23 procedure under certain experimental conditions. Applicant has also broadened the scope of the claim by amending the power transmission fluid to be "substantially free" of dispersant viscosity index improver, rather than "free" as in the previous version of the claims. These new limitations require further consideration, and also further search as the "substantially free" limitation may be met by some power transmission fluids that were previously outside the scope of the claim. The amendment is therefore not entered.

2. Even if the amendment were to be entered, it does not appear to distinguish the claims over the art of record. Srinivasan discloses an automatic transmission fluid with 5-20% by weight of a viscosity index improver which is preferably a non-dispersant polymethacrylate. As Figure 1 of the current application shows that the new limitation of claim 30 is met with a composition comprising 5.13% by weight of a non-dispersant polymethacrylate, the compositions of Srinivasan should also meet the new limitation. Applicant argues that Figures 3 and 4 of Srinivasan demonstrate a torque difference outside the range recited in amended claim 30. However, this conclusion cannot be drawn from Figures 3-4 for several reasons. Figures 3-4 do not reflect the results of a GVRK-Kurztest CFT23 procedure, as recited in amended claim 30. Figures 3-4 only

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show data collected up to 900 milliseconds, while amended claim 30 recites a limitation for the torque difference between 400 and 1000 seconds. Figures 3-4 show the results of three separate trials superimposed upon each other, and it is not possible to determine the torque difference for any individual trial, in particular Example 3 which is the inventive composition of Srinivasan. Finally, the results shown in Figures 3-4 of Srinivasan reflect results obtained with one specific composition, and not the full scope of Srinivasan's disclosure. Srinivasan is silent as to the identity and concentration of the viscosity index improver present in the composition for which results are reported in figures 3-4.

James C. Caldarola
JCG


Glenn Caldarola
Supervisory Patent Examiner
Technology Center 1700